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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,954	02/10/2006	David Jay Duffield	PU040019	5351

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EXAMINER

FULLER, RODNEY EVAN

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2862

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02/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/567,954	Applicant(s) DUFFIELD ET AL.	
	Examiner Rodney E. Fuller	Art Unit 2862	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/10/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because the abstract is not limited to a single paragraph on a separate sheet. Correction is required. See MPEP § 608.01(b).

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following item(s) must be shown or the feature(s) canceled from the claim(s):

- a. (Claim 38): "A medium for storing a recorded movie"
- b. (Claim 38): "a first portion" of the medium
- c. (Claim 38): "a marking pattern"
- d. (Claim 39 and 40): "the medium"

No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 34-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Chaum (US 5,959,717).

Note: Chaum (US 5,959,717) was listed as an X-reference in the International Search Report for PCT/US2004/024074)

Chaum teaches an anti-piracy system that utilizes a marking code, such as a time and place stamp, such that a pirated video tape can be identified. (See Figure 1; column 1, lines 25-33; column 2, lines 34-40). Thus, Chaum teaches (Claim 34): "playing back the recorded movie to view image sequences thereof; and identifying in at least one of the image sequences a marking pattern that was displayed using visible light along with the movie, wherein the marking pattern provides an identification indicative of at least one parameter selected from a group comprising a theater location, a date and a time;" (Claims 35 and 41) "wherein the marking data represents at least one of a theatre identifier, date and/or time;" (Claims 36 and 42): "wherein the marking pattern represents marking data comprising a forward error correction code;" (Claims 37 and 43): "wherein the forward error correction code represents an exclusive NOR operation of at least some of the marking data;" (Claim 38): "a first portion representing a sequence of images representing the movie; wherein at least one of the sequences includes therein a marking pattern that was displayed using visible light along with the movie;" (Claim 39): "wherein the medium is a digital versatile disc (DVD);" and (Claim 40): "wherein the medium is a camcorder tape."

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaum (US 5,959,717) in view of Tehranchi, et al. (US 6,809,792).

Regarding claims 1 and 16, Chaum disclose all the structure set forth in the claims except Chaum does not teach that the security identifier marks are projected from the rear of the screen. However, the projection of a copy-deterrent pattern onto a projected movie picture from the rear of the screen was well known in the art at the time the invention was made as evident from the teachings of Tehranchi (See Figure 2; column 7, lines 3-9). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Chaum by positioning the mark identifier projector at the rear of the screen in order to optimize the displayed intensities and take advantage of the existing tiny perforations in the screen as taught by Tehranchi in column 7, lines 3-9)

Regarding claims 2-5 and 18-23, Chaum discloses " wherein said step of presenting the at least one identifier further comprises the steps of: measuring an illumination of at least a portion of the image sequence presentation; and determining a projection brightness for the at least one identifier based upon the measured illumination." (abstract, lines 22-26; column 3, lines 40-47)

Regarding claims 6 and 24, Chaum discloses "wherein the at least one identifier is presented at periodic intervals." (column 4, lines 65-67)

Regarding claims 7-10 and 25-28, Chaum discloses "wherein the at least one identifier defines at least one parameter selected from the group consisting of a theater location, a date and a time." (column 2, lines 34-42)

Regarding claim 11 and 29, Chaum discloses "wherein the image sequence is a movie." (column 1, lines 12-13)

Regarding claims 12-15 and 30-33, Chaum discloses "wherein the projecting step includes the step of communicating a command for use in controlling the projection of the at least one identifier." (column 6, lines 1-10; column 12, lines 55-56)

Regarding claim 17, Chaum discloses "wherein the at least one identifier is selected from a set of identifiers and wherein the system further comprises a processor (Fig. 4, ref.# 44) coupled to the pattern generator (Fig. 4, ref.# 18) for controlling selection of the at least one identifier from the set of identifiers."

Double Patenting

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claims 34-43 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 23-32 of copending Application No. 10/567,941 (Pub. No.: 2006/0262280) This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney E. Fuller whose telephone number is 571-272-2118. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Assouad can be reached on 571-272-2210. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

February 11, 2008

/Rodney E Fuller/
Primary Examiner, Art Unit 2862

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